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SUPREME COURT OF THE UNITED STATES

October Term, 1941

No. 718

GENERAL MOTORS CORPORATION,
Petitioner,

v.

CONWAY P. COE, Commissioner of Patents,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

GENERAL MOTORS CORPORATION,
By DRURY W. COOPER,
FRANK E. LIVERANCE, JR.,
Counsel for Petitioner.

AMERICAN BRIEF AND RECORD CO., GRAND RAPIDS, MICHIGAN

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

To the Honorable The Chief Justice and Associate Justices of The Supreme Court of The United States:

Your petitioner, GENERAL MOTORS CORPORATION, respectfully prays that a writ of certiorari issue to the United States Court of Appeals for the District of Columbia to review the judgment of that Court entered in the above-entitled cause on June 16th, 1941 (R. 458). A petition for rehearing was denied by the said Court of Appeals on August 1st, 1941 (R. 458). A certified Transcript of Record in this cause including the proceedings in the said Court of Appeals is furnished in accordance with Rule 38 of this Court.

Summary and Short Statement

This action was brought in the District Court for the District of Columbia under the Act of March 2, 1929, C. 488, Sec. 2 (b), 45 Stat. 1476, R.S. Sec. 4915 (U. S. Code, Title 35, Sec. 63, as amended March 2, 1929) to obtain

Letters Patent for an invention of Ernest E. Wilson, assigned to your petitioner.

Wilson's invention is for a silencer by which the intake or exhaust noise of an internal combustion engine may be silenced without restricting air entrance into or exhaust gas discharge from the engine cylinders. The Wilson application illustrates (R. 143-144) a number of forms of the silencer.

Restriction of exhaust gas discharge from its cylinders lowers, and restriction of air entrance into its cylinders much more pronouncedly lowers the efficiency of an engine (R. 16-17, 26; 38-40; 55-57, 59). This had long been universally recognized and a silencer which would not restrict air entrance into or the exhaust gas discharge from the cylinders of an engine had long been sought. At the time Wilson made his invention all exhaust silencers in use inherently considerably restricted exhaust gas discharge from the cylinders; and few intake silencers were used,* because none were available which would not unduly restrict air entrance into the cylinders of the engine resulting in loss of power and increased fuel consumption (R. 16-17; 26; 37-40; 50; 57).

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*Wilson testified that he knew of but two (R. 16). Kamrath, silencer engineer for AC Spark Plug Division of your petitioner, identified these as the Nash silencer, Exhibits 11 and 12 and the Buick silencer, Exhibit 13 and testified that they were displaced by the Wilson silencer as soon as it became available (R. 37-40).

Silencers of Wilson's invention have concededly attained "great commercial success"* (R. 455). They represent the only known means of silencing intake or exhaust noises of an engine without lessening its efficiency. Lessened efficiency means reducing the horsepower available and increasing fuel consumption — a matter of concern at all times, and especially at present.

Wilson's silencers are based on a principle of acoustics — a Helmholtz resonator's capability of attenuating sound waves whose frequency equals its natural frequency — known to the world before 1896** but not prior to Wilson's invention applied to any practical use. Wilson was told by associates that the principle could not be employed to silence the intake or exhaust noises of an engine (R. 25). Of course, Wilson's invention involved much more than just connecting a Helmholtz resonator to intake or exhaust pipes of an engine. The U. S. Court of Appeals D. C. has recognized the *great importance* of the *modifications* made in chambers of the prior art to apply the teachings of Rayleigh (R. 456). Lord Rayleigh's treatise in date was long before automobiles were

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*Intake silencers in accordance with Wilson's invention were first put on the market in 1930. Within a short time they were standard original equipment on *all* automobiles made in this country. At the time of the trial in the District Court (November 1939) nineteen million (19,000,000) of them had been made and used in this country. Wilson's invention thus created a new industry. Exhaust silencers in accordance with Wilson's invention are standard original equipment on several automobiles made in this country. Silencers in accordance with Wilson's invention are also used on a number of trucks and tractors made in this country and on a number of automotive vehicles made in foreign countries (R. 24-25; 30; 37; 41-43).

**The principle is referred to in the *second* (1896) edition of Lord Rayleigh's treatise entitled "Theory of Sound" (R. 368); and Dr. Chamberlain testified (R. 80) in periodicals of earlier date.

anything but curiosities. No one prior to Wilson, during 30 years of intensive automotive development, got the invention because of this treatise. Yet without this publication of Lord Rayleigh there could have been no basis for even a doubt as to invention being present in the Wilson development.

The Wilson application was filed on July 25, 1930. Broad claims were allowed — on November 4, 1931 (R. 81) by one Examiner and on July 28, 1932 (R. 192) after reexamination by his successor. Thereafter the Wilson application was in interferences, all won by Wilson. After the interferences the successor to the second Examiner reexamined the Wilson application and rejected the broader of the claims allowed by his predecessors.

The third Examiner eventually finally rejected the broader claims before him. The Board of Appeals of the Patent Office in a manifestly ill considered decision affirmed his decision except as to three of these claims (R. 443-452).

The District Court allowed two of the claims refused by the Board but dismissed your petitioner's bill as to the remainder as not patentable over the prior art of record (R. 89). Claim 92, (R. 4), allowed by the District Court, differs from most of the claims (e.g. claim 109, R. 5) disallowed by the District Court and the Court of Appeals only in the addition of an old feature which is clearly disclosed in the prior patent to Powell (R. 304). That is, the novelty upon which the allowance of claim 92 must have been predicated — the tuning, or the dimensioning of the resonator — is also defined in most of the claims disallowed by the District Court. The District Court made no findings of fact (R. 90-92) to support its conclusion that the claims it disallowed were not patentable over the prior art of record.

The Court of Appeals refused (R. 457) to consider the circumstance that the inventive novelty upon which claim 92 must have been allowed was also found in most of the claims before it. It also refused (R. 456-457) to consider the long period between the publication of Lord

Rayleigh's treatise and Wilson's invention as evidence, with respect to the claims before it, of invention in applying the principle disclosed in Lord Rayleigh's treatise to internal combustion engine intake and exhaust silencers.

The Court of Appeals conceded that Wilson's invention had attained "great commercial success", that the automobile engine silencers in the prior art of record do not operate as resonators (R. 455), that the modifications required to apply to automobile engine mufflers of the principle disclosed in Lord Rayleigh's treatise were "of great importance" (R. 456) and that "the presence or absence of invention is doubtful in this case" (R. 456). But the Court of Appeals affirmed the decision of the District Court because it said

> "we cannot say that it (the application of principle disclosed in Lord Rayleigh's treatise to internal combustion engine silencers) clearly required the uncommon talent of an inventor"

and

> " 'Whatever else may be said of older decisions that, in appeals from the Patent Office, doubt was to be resolved in favor of the applicant, they are obviously not law in relation to appeals from the District Court.' It is the settled law of this Court that we must sustain the findings of the Patent Office and the District Court unless we think them clearly wrong. In other words doubt is to be resolved, in suits to obtain a patent as in suits of other sorts, in favor of the correctness of administrative and judicial action."

It is clear from the opinion of the Court of Appeals that its doubt of the lack of invention in this case was a substantial, well-founded doubt and that the Court resolved this doubt against your petitioner, notwithstanding the advance made was accompanied by recognized in-

dicia of inventions, and there was disagreement within and among the tribunals below.***

The Questions Presented by this Petition

The decision of the Court of Appeals obviously turned upon whether the Court should resolve substantial, well-founded doubt respecting lack of invention in favor of or against the applicant. Notwithstanding the advance was accompanied by recognized indicia of invention*; and there was disagreement within and among the tribunals below,** the Court resolved such doubt against the ap-

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*The Court of Appeals conceded that what Wilson did was novel, "of great importance" and "achieved great commercial success." But this brief resume does not do Wilson's invention justice. It was the long sought for solution to the problem of how to silence the intake or exhaust of an engine without reducing its efficiency and the first and only satisfactory solution to the problem of silencing the intake. It increased the horsepower available from and reduced the fuel consumption of engines. It immediately supplanted and superseded the few intake silencers in use at the time it became available and within a short time was *standard original equipment* on *all automobiles* made in this country. It created the intake silencer industry. Rayleigh's treatise without which invention would never have been questioned is of ancient vintage. It was not to be expected that the principle referred to in Rayleigh's treatise could be used to silence an engine. In the case of most of the claims involved in the appeal their disallowance was inconsistent with the allowance of claim 92. All of these things are amply established and none of them except that need for the invention was long felt is questioned by the Court of Appeals.

**The presumption of correctness of the decisions of lower tribunals is weakened by disagreement within and among them. *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corporation et al,* 294 U. S. 477, 480; *In re Wilson,* 49 App. D. C. ———, 258 F. 976.

plicant because it said, quoting dictum from *Minnesota Mining & Mfg. Co. v. Coe,* 118 F. (2d) 593, 594:

> "Whatever else may be said of older decisions that, in appeals from the Patent Office, doubt was to be resolved in favor of the applicant they are obviously not law in relation to appeals from the District Court."

The decision of the Court of Appeals of the District of Columbia, consequently, presents the following questions:

The First Question

Whether the United States Court of Appeals for the District of Columbia in an action under R.S. Sec. 4915 against the Commissioner of Patents should resolve against the applicant for patent substantial, well-founded doubt of lack of invention in the advance for which a patent is sought.

The Second Question

This question need be considered only in the event the preceding question is answered in the affirmative. It is:

Whether the United States Court of Appeals for the District of Columbia in an action under Sec. 4915 R.S. against the Commissioner of Patents should resolve substantial, well-founded doubt of lack of invention in the advance for which a patent is sought against the applicant for patent in a case in which in addition to substantial novelty there is conceded "great importance", "great commercial success", and there was disagreement within and among the tribunals below.

The Third Question

If the first question or the second question is answered in the negative this question need not be considered. It is:

Whether the United States Court of Appeals for the District of Columbia, in an action under Sec. 4915 R.S. against the Commissioner of Patents, should resolve substantial well-founded doubt of lack of invention in the advance for which a patent was sought against the applicant for a patent in a case in which in addition to substantial novelty the Court conceded "great importance" and "great commercial success", there was disagreement within and among the tribunals below, and the following circumstances also obtain:

The advance was the first and only satisfactory solution to a problem which had long existed and been recognized. It resulted in increase in efficiency and reduction in cost of operation. It immediately supplanted and superseded the few things in use in an important field of its application and within a short time was used universally and *exclusively* in that field. It created a new industry. A prior art item without which invention would never have been questioned is of ancient vintage. It was not to be expected that the principle referred to in the prior art item could be used to do what the applicant's invention does. In the case of most of the claims involved in the appeal their disallowance is inconsistent with the allowance of another claim.

The Reasons Relied Upon for the Grant of the Writ

I.

The questions presented by the decision of the Court of Appeals in this cause are of great importance to inventors, industry and the country as a whole.

II.

The precise questions presented by the decision of the Court of Appeals in this cause have not been passed on by the Supreme Court.

III.

The decision of the Court of Appeals on the questions presented by its decision in this cause is in conflict with the applicable decisions of the Supreme Court.

IV.

The decision of the Court of Appeals on the questions presented by its decision in this cause is in conflict with the decisions of all other tribunals which deal with applications for patents.

V.

The decision of the Court of Appeals on the questions presented by its decision in this cause is in conflict with the decisions of the same Court in appeals from the Patent Office and with other decisions by it in actions against the Commissioner of Patents under R.S. Sec. 4915.

VI.

There is disagreement within the Court of Appeals itself with respect to the proper answers to the questions presented by its decision in this cause.

VII.

Conflict between the decision of the United States Court of Appeals for the District of Columbia and a decision of another United States Court of Appeals on the questions presented by the decision of the former in this cause is wholly unlikely.

VIII.

The decision of the Court of Appeals on the questions presented by its decision in this cause results from confusion and misapplication of two entirely separate and distinct rules of law, viz., the rule that substantial, well-

founded doubt as to lack of invention should be resolved in favor of the applicant, and the rule that the decisions of lower tribunals are presumed to be correct and are not to be reversed just because of doubt as to their correctness.

Wherefore, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Court directed to the United States Court of Appeals for the District of Columbia, commanding said Court of Appeals to certify and send to this Court on a day to be designated a full Transcript of the Record and all proceedings had in the said Court of Appeals in this cause, to the end that the same may be reviewed and determined by this Court; and the judgment of said Court of Appeals be reversed and that petitioner be granted such other and further relief as may be deemed proper.

GENERAL MOTORS CORPORATION,
Petitioner.
By DRURY W. COOPER,
FRANK E. LIVERANCE, JR.,
Counsel for Petitioner.

October 16, 1941.

SUPREME COURT OF THE UNITED STATES

October Term, 1941

No.————

GENERAL MOTORS CORPORATION,
Petitioner,

v.

CONWAY P. COE, Commissioner of Patents,
Respondent.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Opinions of Courts Below

The opinion of the Court of Appeals in this cause is reported in 120 F. (2d) 736. It is at pp. 455 to 457 of this record. The memorandum opinion of the District Court is at R. 89, and its findings of fact and conclusions of law at R. 90 to 92.

Jurisdiction

Jurisdiction to entertain this petition and review this cause is conferred upon this Court by Section 240 (a) of the Judicial Code, U.S.C., title 28, Sec. 347, as amended January 31, 1928 (45 Stat. 54).

The petition is timely, being within three months from and after the denial of the petition for rehearing (August 1st, 1941, R. 458). The judgment of the Court of Appeals is final.

Statement of the Case

The case presented by the petition is adequately set forth in the petition.

Specification of Errors

1. The Court of Appeals erred in holding that in an action under R.S. Sec. 4915 against the Commissioner of Patents substantial, well-founded doubt of lack of invention in the advance for which a patent is sought should be resolved against the applicant for patent.

2. The Court of Appeals erred in holding that in an action under R. S. Sec. 4915 against the Commissioner of Patents substantial, well-founded doubt of lack of invention in the advance for which a patent is sought should be resolved against the applicant for patent in a case in which the advance in addition to substantial novelty was concededly accompanied by such indicia of invention as "great importance", "great commercial success" and there is disagreement within and among the tribunals below.

3. The Court of Appeals erred in refusing to consider the inconsistency of the allowance of claim 92 and the disallowance of claim 109 and other claims in which are found the only novel and inventive feature upon which the allowance of claim 92 could have been predicated.

4. The Court of Appeals erred in refusing to consider the circumstance that there is no basis in the District Court's findings of fact for its conclusion that the claims involved in the appeal were unpatentable.

5. The Court of Appeals erred in not taking into account as an indication of invention with respect to the claims involved in the appeal the circumstance that many years, covering the period of intensive development of the automobile from its infancy to one of the great major industries elapsed between the dates of Rayleigh's treatise and Wilson's invention.

6. The Court of Appeals erred in holding that the desirability and need for Wilson's invention were not recognized and felt until shortly before Wilson produced it.

7. The Court of Appeals erred in holding that "The modification of the muffling chambers of Hooton, etc.,

so as to apply the teachings of Rayleigh and Stewart" did not clearly require "the uncommon talent of an inventor."

8. The Court of Appeals erred in holding that the uncommon talent of an inventor was not "clearly required to conceive of selecting — the particular sound waves which particular engines produced in such degree as to make it desirable to muffle them."

9. The Court of Appeals erred in not holding that the facts and circumstances which obtain in this case clearly demonstrate that the advance for which your petitioner is seeking a patent is of inventive character.

10. The Court of Appeals erred in not holding that your petitioner is entitled to a patent with the claims involved in the appeal and in not reversing the decision of the District Court.

Summary of Argument

The argument is summarized in the sections of the foregoing petition entitled *The Reasons Relied Upon for the Grant of the Writ.*

ARGUMENT

I.

The Importance of the Questions Presented by the Decision of the Court of Appeals.

The decision of the Court of Appeals in this cause unless revised by the Supreme Court will, we predict, eventually result in destruction of the patent system of this country. We say this with great seriousness without attempt to exaggerate. Immediately it will, in effect, nullify the right of appeal in actions against the Commissioner of Patents under R.S. Sec. 4915 and rout everything going beyond the Board of Appeals to the Court of Customs and Patent Appeals because under the rule applied by the Court of Appeals no appeal can succeed

unless the appellant can convince the Court that beyond a doubt the advance for which a patent is sought is of inventive character, and this confronted by the opposite decisions of the District Court and the Patent Office tribunals. Eventually the rule applied by the Court of Appeals in this cause will naturally, if it is approved by the Supreme Court by refusal to review the decision or by affirmance of the decision if it agrees to review it, be adopted by the other tribunals which deal with patent applications, viz., the United States District Court for the District of Columbia, the United States Court of Customs and Patent Appeals and the United States Patent Office. No reason exists for a different rule in the Court of Appeals of the District of Columbia than in these other tribunals as to resolution of doubt of lack of patentability. All of the other tribunals, except the lower Patent Office tribunal, are tribunals of review insofar as applications for patents are concerned.

The application by the other tribunals which deal with applications for patent of the rule applied by the Court of Appeals of the District of Columbia will mean that an applicant will be unable to obtain a patent unless he can prove beyond doubt that the advance for which he seeks a patent was of inventive character. Obviously this would be possible in few, if any, cases because unless the prosecuting of the application for patent is prolonged there will not be an opportunity for adequate exploitation of the invention before the prosecution is terminated. Under R.S. Sec. 4886 (U. S. C. Title 35, Section 31), as amended by the Act of August 5, 1939 (53 Stat. 1212) an application for patent must be filed within one year from the date that the invention was first put into public use or on sale in this country.*

The decision of the Court of Appeals in this cause makes it more difficult to get a patent than to sustain one. In a suit for infringement of a patent a substantial, well-founded doubt of lack of invention would be resolved

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*See Appendix.

in favor of the patentee by the indicia of invention which are not denied or questioned in this case.

In *Smith v. Goodyear Dental Vulcanite Company,* 93 U. S. 486, 495, 496, this Court said:

> "We do not say, the single fact that a device has gone into general use and has displaced other devices which had previously been employed for analogous uses establishes in all cases that the later device involves a patentable invention. It may, however, always be considered; and when the other facts in the case leave the question in doubt, it is sufficient to turn the scale."

In *Krementz v. The S. Cottle Company,* 148 U. S. 556, 560, 561, this Court said:

> "Yet, as was well said by Mr. Justice Brown in the case of Consolidated Brake-Shoe Co. v. Detroit Co., 47 Fed. Rep. 894, 'when the other facts in the case leave the question of invention in doubt, the fact that the device has gone into general use and has displaced other devices which had previously been employed for analogous uses, is sufficient to turn the scale in favor of the existence of invention.' "

In *Minerals Separation, Ltd. et al v. Hyde,* 242 U. S. 261, 270 this Court said:

> "The record shows not only that the process in suit was promptly considered by the patentee as an original and important discovery, but that it was immediately generally accepted as so great an advance over any process known before that, without puffing or other business exploitation, it promptly came into extensive use for the concentration of ores in most, if not all, of the principal mining countries of the world, notably in the United States, Australia, Sweden, Chile and Cuba, and that, because of its economy and simplicity, it has largely replaced all earlier processes. This, of itself, is persuasive evidence of that invention which it is the

purpose of the patent laws to reward and protect. *Diamond Rubber Co. v. Consolidated Tire Co.*, 220 U. S. 428; *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 429, 430; *The Barbed Wire Patent*, 143 U. S. 275; *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 486."

Other Supreme Court cases to the same effect are in the footnote.*

What must an applicant show in order to get a patent, if what has been shown in this case will not suffice? This is submitted as a fair question for the respondent to answer.

An erroneous grant of a patent is corrected by a Court in an infringement suit. The patentee may correct it by disclaimer. No Court in an infringement action can correct a wrong decision which refuses a patent which should have been granted. Patents are *prima facie* valid only, and error in granting is correctable upon putting the patent to test and otherwise. It would seem to be a common sense conclusion that the burden imposed upon an applicant to get a patent should be less and not greater than that of sustaining it.

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*Expanded Metal Co. v. Bradford, 214 U. S. 366, 29 S. Ct. 652, 53 L. Ed. 1034; Olin v. Timken, 155 U. S. 141, 15 S. Ct. 49, 39 L. Ed. 100; Seabury v. Am Ende, 152 U. S. 561, 14 S. Ct. 683, 38 L. Ed. 553; Keystone Mfg. Co. v. Adams, 151 U. S. 139, 14 S. Ct. 295, 38 L. Ed. 103; Duer v. Corbin Cabinet Lock Co., 149 U. S. 216, 13 S. Ct. 850, 37 L. Ed. 707; Grant v. Walter, 148 U. S. 547, 13 S. Ct. 699, 37 L. Ed. 552; Gandy v. Main Belting Co., 143 U. S. 587, 12 S. Ct. 598, 36 L. Ed. 272; McCreary v. Pennsylvania Canal Co., 141 U. S. 459, 12 S. Ct. 40, 35 L. Ed. 817; McClain v. Ortmayer, 141 U. S. 419, 12 S. Ct. 76, 35 L. Ed. 800; Magowan v. New York Belting etc. Co., 141 U. S. 332, 12 S. Ct. 71, 35 L. Ed. 781; Webster Loom Co. v. Higgins, 105 U. S. 580, 26 L. Ed. 1177.

II.

The Questions Presented by the Decision of the Court of Appeals have not been passed on by this Court.

While as we have indicated in the foregoing section of this brief this Court has rendered decisions which the Court of Appeals should have considered controlling, it has not passed on the precise questions presented by the decision of the Court of Appeals, i. e. the rule of doubt in the case of applications for patents as distinguished from patents. And in view of the importance of these questions to inventors, industry and the country as a whole we submit this Court should pass on them.

III.

The Decision of the Court of Appeals is in Conflict with the Applicable Decisions of this Court.

In support of this statement we think it is necessary only to refer again to *Smith v. Goodyear Dental Vulcanite Company, Krementz v. The S. Cottle Company, Minerals Separation Ltd. et al v. Hyde,* supra, and the other decisions of this Court cited in Section I of this brief.

IV.

The Decision of the Court of Appeals on the Questions Presented by its Decision is in Conflict with the Decisions of all other Tribunals Which Deal With Applications for Patent.

In an *ex parte* proceeding to obtain a patent, upon appeal to the United States Court of Customs and Patent Appeals, that Court operates as in *In re Breer,* 55 F. (2d) 485. Breer had a novel and useful structure, leaving the question of invention to be determined under proper application of rules of law to the facts found. The Court said it was not unmindful of the fact that *both* of the Patent Office tribunals had held that it did not involve

invention; and then stated "the *well established rule* that in such cases we will not reverse their findings unless they are *manifestly wrong.*" Thus far there is agreement with the Court of Appeals in this cause when it says:

> "It is settled law of this court that we must sustain the findings of the Patent Office and District Court unless we think them *clearly wrong.*"

The Court of Customs and Patent Appeals in the Breer case found on the record "doubt as to lack of patentability of the claims in issue" the same as the Court of Appeals did herein. It then stated that the finding of such doubt required:

> "the application of the rule that where well-founded doubt of lack of patentability exists, such doubt should be resolved in favor of the inventor."

This is what we asked of the Court of Appeals. It found substantial, well-founded doubt, but then said that it was "obviously not law in relation to appeals from the District Court" to resolve such doubt in favor of the inventor.

The Patent Office, of course, follows the same rule as the Court of Customs and Patent Appeals and as did the Court of Appeals of the District of Columbia when it exercised the jurisdiction now exercised by the Court of Customs and Patent Appeals. To demonstrate we quote from the Court of Appeals decision in *In re Thomson*, 26 App. D. C. 425, 1906 C.D. 566, 120 O.G. 2756, in which the Court said at 1906 C.D. 571:

> "In case of ordinary doubt, *the policy of the patent system*, as customarily maintained in the Patent Office, has been to give the applicant the benefit thereof, because no absolute right or property is conferred by the grant of a patent (ex parte Fanshawe, C.D., 1891, 203; 57 O.G. 1127)."

In the actions under R.S. Sec. 4915 against the Commissioner of Patents which it tried, the United States District Court for the District of Maryland followed the rule of doubt. *Kaplan v. Robertson*, 50 F. (2d) 617 and *Berry v. Robertson*, 50 F. (2d) 915, in the latter of which at 50 F. (2d) 921 it is said:

> "Were there any doubt as to the patentability of the device here in issue, the Court would be compelled to resolve the doubt in favor of the plaintiff because of commercial success of the device as indicated by testimony which was not contradicted."

No reason exists for a different rule in the Court of Appeals for the District of Columbia than in the other tribunals which deal with applications for patents as to resolution of doubt of lack of invention.

As a matter of sound principle when, in a proceeding to obtain a patent, there is doubt as to lack of invention, the rule should be, as it always has been and still is except in part of the Court of Appeals of the District of Columbia, that the patent should be granted. Otherwise injury may be done for which there is no remedy. Doubtful questions as to invention and a determination of the questions will thus be left to the Court handling the matter in an infringement action, where all the evidence may be produced both for and against the invention in question. If the patent should not have been granted the Court says so and the error in granting is remedied. If a patent is refused that should have been granted, there is no remedy.

V.

The Decision of the Court of Appeals is in Conflict with its Decisions when it had jurisdiction of Appeals from the Patent Office and with its earlier Decisions in Actions Against the Commissioner of Patents under R. S. Section 4915.

When it had jurisdiction of appeals from the Patent Office the Court of Appeals for the District of Columbia uniformly held from time immemorial that substantial, well-founded doubt of lack of invention should be resolved in favor of the applicant. There are said to be upwards of fifty cases in which the Court enunciated the rule. In a footnote to Section 178 (page 139) 48 Corpus Juris cites more than thirty decisions in support of the rule. That the Court of Appeals of the District of Columbia considered the rule a general one of the law of patents and not merely one beneficently applied by particular Courts is clear from its reference to it in *In re Thomson*, supra, as "the policy of the Patent system."

The Court of Appeals of the District of Columbia recognized the rule in the following actions under R.S. Sec. 4915: *Thornton v. Coe*, 102 F. (2d) 247; *Carbide and Carbon Chemicals Corporation v. Coe*, 102 F. (2d) 236; *Battery Patents Corporation v. Coe*, 93 F. (2d) 220; and *Freyn Engineering Co. v. Coe*, 79 F. (2d) 134. In the case last mentioned the Court said:

> "Where a doubt exists as to the question of novelty, commercial success may justify the Court in resolving the doubt in favor of the applicant." *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, 55 S. Ct. 449, 79 L. Ed. 997, decided Mar. 4, 1935."

In *Battery Patents Corporation v. Coe*, the Court of Appeals considered the rule of doubt in conjunction with the rule of presumption of correctness of the decisions of lower tribunals and arrived at the same conclusion as

did the Court of Customs and Patent Appeals in *In re Breer*, supra.

VI.

There is Disagreement Within the Court of Appeals Itself with Respect to the Proper Answer to the Questions Presented by its Decision in this Cause.

Late in 1938 two decisions were handed down by the Court of Appeals of the District of Columbia, one, *Carbide and Carbon Chemicals Corp. v. Coe, supra,* the other *Thornton v. Coe, supra.* In each, the majority of the Court on the merits of the case as had always been previous practice* and still is at times** applied proper rules of law to the facts and ruled that a patent should be granted.

There was a dissenting opinion in both cases.

Eleven months later in *Abbott v. Coe,* 109 F. (2d) 449 such dissenting opinions became the opinion of the Court, neither Justice of the majority opinion in *Carbide and Carbon Chemicals Corp. v. Coe* and *Thornton v. Coe* sitting in *Abbott v. Coe.*

In *Abbott v. Coe, supra,* the Court announced the rule:

> "The question for us is not whether in our opinion there was invention, but whether the finding there was none is consistent with the evidence."

The dissenting opinions in *Carbide and Carbon Chemicals Corp. v. Coe, supra,* and *Thornton v. Coe, supra,* mark the first attempt to avoid considering the merits of the case to determine whether or not a patent should be granted, followed, as the next step by *Abbott v. Coe, supra.*

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*Gasoline Products v. Coe, 87 F. (2d) 550; Hartford Empire Co. v. Coe, 87 F. (2d) 741; Otto v. Robertson, 66 F. (2d) 213; Lucke v. Coe, 69 F. (2d) 379; Wach v. Coe, 77 F. (2d) 113.

**Poulsen et al. v. Coe, 119 F. (2d) 188.

In subsequent cases involving *ex parte* applications for patent there was a persistent citing of *Abbott v. Coe, supra.* In *Wolf et al v. Coe,* 112 F. (2d) 857; *Eppensteiner v. Coe,* 114 F. (2d) 457; *Forward Process Co. v. Coe,* 116 F. (2d) 946; *Minnesota Mining & Mfg. Co. v. Coe,* 118 F. (2d) 593; and in this case. In the Minnesota Mining & Mfg. Co. case a dictum, that doubt previously resolved in favor of the applicant was obviously not law in relation to appeals from the District Court first appears. Such dictum would appear unnecessary, volunteered and out of place in the decision. For the decision of the majority was upon a factual basis, that the District Court should be affirmed because its decision was consistent with the evidence. The decision says nothing about invention being in doubt, as found by the Court in the present case.

Then such dictum in the Minnesota Mining & Mfg. Co. case was seized upon in this case to be a rule of law contrary to all previous authority of which there is an overwhelming weight of earlier decisions of the United States Court of Appeals for the District of Columbia and of other Courts.

Mr. Justice Stephens not sitting in Abbott v. Coe but sitting in *Minnesota Mining & Mfg Co. v. Coe,* in *Forward Process Co. v. Coe,* in *Wolf et al v. Coe* and in *Eppensteiner v. Coe,* by dissent in two of such cases and concurrence only in the result on the merits in the other two, has shown disagreement with such reversal of previous settled practice and overruling of settled law that doubt as to the presence or absence of invention should be resolved in favor of the inventor, leaving any doubt as to invention to be determined when the patent was put to a test, and not through error refusing patent protection and thus inflicting injury incapable of remedy.

There has been a turnabout and reversal of what the Court of Appeals for the District of Columbia has always previously followed as a settled rule of law, particularly when, from the evidence, the doubt is resolvable

by the proven and conceded indicia of invention, *Thornton v. Coe, supra.*

There is nothing settled *now* in the Court of Appeals of the District of Columbia regarding the application of rules of law to the fact findings made by the Court in appeals in actions under R.S. Sec. 4915 to determine the question of patentability.

The matter is in chaos. The Court is divided. There is no certainty and there is confusion which cries for settlement.

The dictum, without authority or reason, from *Minnesota Mining & Mfg. Co. v. Coe, supra,* stated as a rule of law, controlled the decision in this case. There is division and dissent in the Court. It is submitted that such division in connection with the revolutionary reversal of previously settled law should be an important and valid reason for the Supreme Court to grant certiorari for a review and settlement of the matter.

Unquestionably there should be certainty and not confusion and chaos and the element of chance involved in law applicable to actions under R.S. Sec. 4915, as in all actions. Today on an appeal from the District Court of the District of Columbia to its Court of Appeals in an action against the Commissioner of Patents to obtain a patent there is no such certainty and the *element of chance* is involved, namely, who is going to hear the appeal. Will the appeal be decided as in this case, or will it be a determination as in *Thornton v. Coe, supra, Otto v. Robertson, supra,* or as recently in *Poulsen et al v. Coe,* 119 F. (2d) 188 with doubt of lack of patentability resolved in favor of the applicant; particularly in cases of abundant concession and proof of legally recognized evidence of invention.

VII.

Conflict of Decisions Between the United States Court of Appeals for the District of Columbia and Another United States Court of Appeals on the Questions Presented by the Decision of the Former in this Cause is Altogether Unlikely.

The reason for this is that the Commissioner of Patents refuses to submit to the jurisdiction of any other United States District Court than the District Court for the District of Columbia. Mr. Robertson as Commissioner of Patents accepted service in the District Court of Maryland (*Kaplan v. Robertson* and *Berry v. Robertson, supra*) but that practice, once followed can be no longer used.

VIII.

The Decision of the Court of Appeals on the Questions Presented by its Decision in this Cause Results from Confusion of Two Entirely Separate and Distinct Rules of Law.

Sustaining the District Court and the Patent Office unless found clearly wrong is the rule in both the United States Court of Appeals for the District of Columbia and the United States Court of Customs and Patent Appeals. In other words, if there is merely doubt as to the *correctness of a decision* of the Patent Office or of the District Court the universal rule of appellate procedure is followed and there is affirmance.

We think that this is the rule followed by all appellate tribunals. There is a presumption that the lower tribunal is correct.

Doubt as to lack of *patentability* is found or not found upon the record of the case not by the Appellate Court alone, but by tribunals of original jurisdiction handling patent applications. The error in this case lies in an assumption that the rule that decisions of lower tribunals

are not to be reversed on mere doubts of their correctness and the rule with respect to doubt as to the presence or absence of invention are identical. The latter rule is another way of saying that if the absence of invention does not clearly appear, the patent is to be granted. Thus a finding by the Appellate tribunal that "the presence or absence of invention is doubtful in this case" establishes patentability. Patentability having been established, the presumption of correctness of the lower tribunal's refusal of patentability is overcome, such decision is clearly wrong, and there cannot be merely doubt as to its incorrectness. It is conclusively wrong.

The decision is based upon an obviously fallacious making identical two separate, distinct, consistent legal rules. It is a source of confusion and chaos and will continue to be until it is authoritatively corrected.

The rule of doubt is not a rule predicated on commiseration of inventors. It is founded on a sound legal principle. A patent application with the prescribed oath makes a prima facie case of invention.

48 Corpus Juris, 139, says

> "The oath of applicant is prima facie evidence of the invention."

Robinson on Patents in Section 123, (Volume 1, page 177) says:

> "But where legal novelty is present the law permits the alleged inventor to prove, if he can do so, that the invention has originated in his own inventive skill. For this his individual statement under oath, if not opposed by other evidence, may be sufficient. His long research and repeated trials may confirm, or his opportunity to imitate the arts or instruments of others may contradict his statement. The whole question is here open for the exhibition of any competent testimony; his own oath constituting prima facie proof, and *in a case of doubt the presumption always being in his favor.*"

The burden of showing lack of invention is thus put upon the Commissioner of Patents, and is not to be disregarded at any stage of any proceeding to obtain a patent. The rule of doubt is time tested, practical and workable. Any other rule would destroy the patent system by putting on applicants a burden that few, if any, could sustain.

CONCLUSION

It is very earnestly urged that the petition be granted. The questions presented and an authoritative answer thereto far transcend the interest of the petitioner in this cause. It is a matter, we submit, of vital public interest. Emasculation and substantial destruction of the patent system of the United States, we believe, will follow if the reversal of previously settled law and practice fully pointed out is not stopped, by a reversal of the United States Court of Appeals for the District of Columbia in this cause and a settlement of the serious uncertainty, confusion and chaos in the law now existing.

Very respectfully,

GENERAL MOTORS CORPORATION,

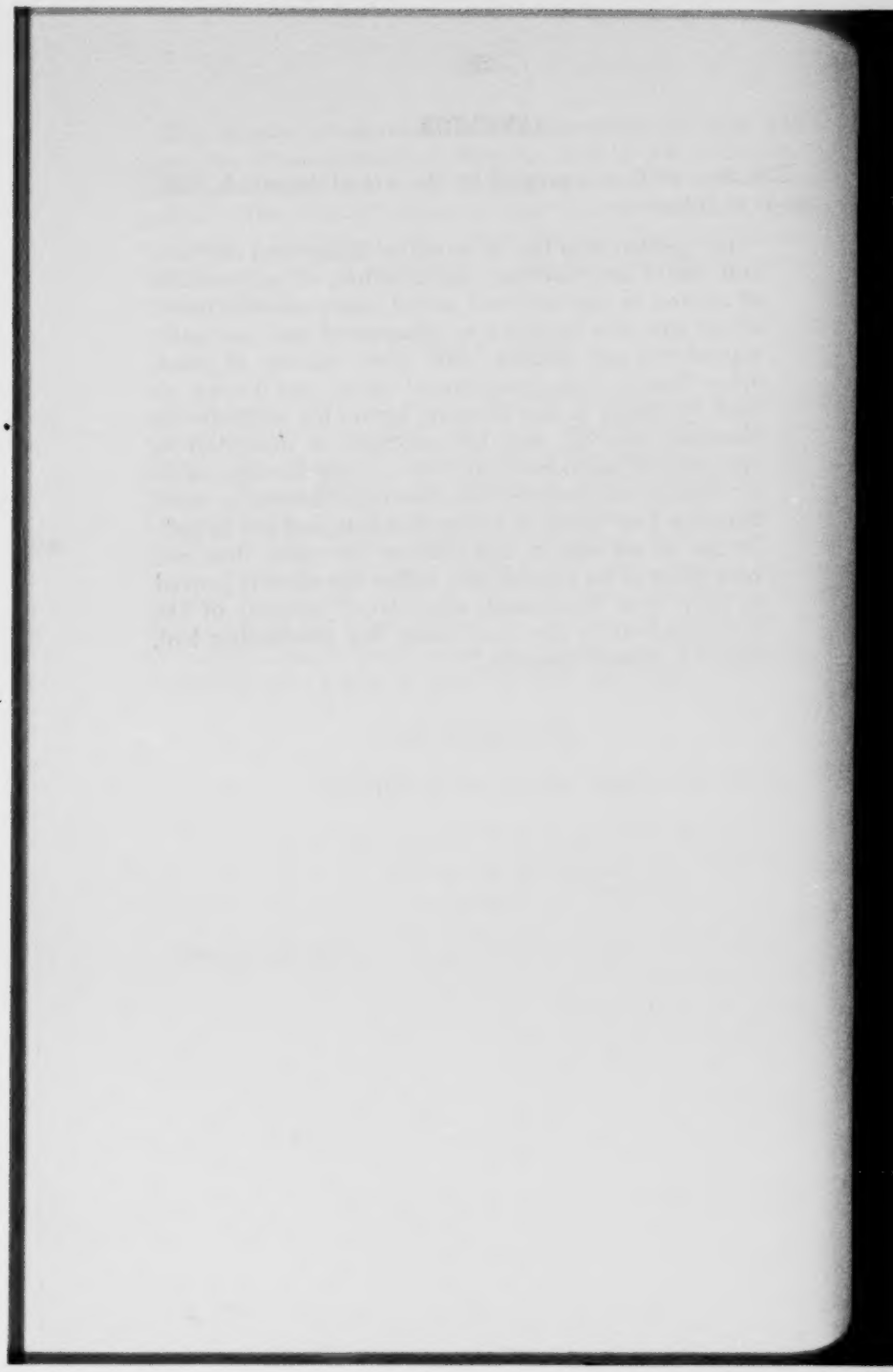
By DRURY W. COOPER,
FRANK E. LIVERANCE, JR.,
Counsel for Petitioner.

October 16, 1941.

APPENDIX

R.S. Sec. 4886, as amended by the Act of August 5, 1939, reads as follows:

> "Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."



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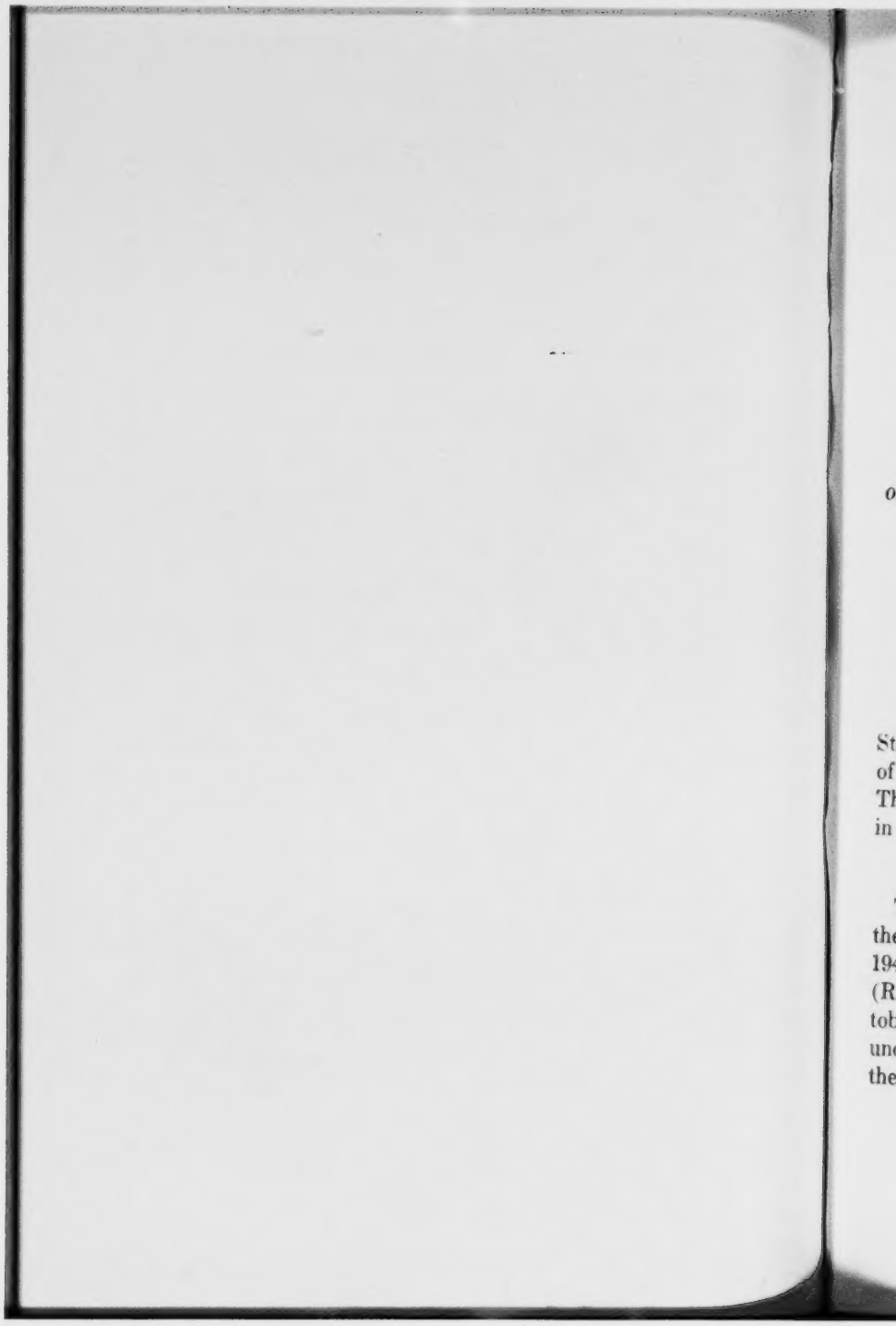

In the Supreme Court of the United States

OCTOBER TERM, 1941

No. 718

GENERAL MOTORS CORPORATION, PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The memorandum of the District Court of the United States for the District of Columbia (R. 89) and the findings of fact and conclusions of law (R. 90–92) are not reported. The opinion of the Court of Appeals (R. 455–457) is reported in 120 F. (2d) 736.

JURISDICTION

The judgment of the United States Court of Appeals for the District of Columbia (R. 458) was entered on June 16, 1941. A motion for rehearing was denied on August 1, 1941 (R. 458). The petition for a writ of certiorari was filed October 27, 1941. The jurisdiction of this Court is invoked under section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTIONS PRESENTED

1. Whether, where invention is doubtful, a finding of no invention by the Patent Office and the District Court may be set aside on appellate review if there is substantial evidence to support such finding.

2. Whether, where invention is doubtful and the claimed invention has attained commercial success, the applicant is conclusively entitled to the issuance of a patent.

STATUTE INVOLVED

Revised Statutes, sec. 4915, as amended by the Act of March 2, 1927, sec. 11, 44 Stat. 1335, and Act of March 2, 1929, sec. 2 (b), 45 Stat. 1475 (35 U. S. C. 63):

> Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the board of appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party, a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may

impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

STATEMENT

The petitioner is the assignee of a patent application filed in the Patent Office on July 25, 1930, by one Ernest E. Wilson (R. 3, 11). The application deals with a device for the absorption of the intake or exhaust noise of an internal combustion engine by means of resonators. The claims set forth in the application disclose a duct through which gases and sound waves travel and which communicates with a single or compound resonator, the resonator being tuned to respond to and attenuate the sound waves of a preselected frequency traveling through the duct (R. 3–8, 90–91, 379, 455). In commercial usage the petitioner's device has attained success and is now in general use in the automobile industry (R. 24–25, 41–43, 455). The prior art disclosed that sound could be absorbed by the use of resonators (R. 379–82, 389–98); that compound resonators were substantially more efficient than a single resonator (R. 382–84, 398–400); and provided formulae for computing the resonance frequency of both single and compound resonance chambers (R. 398–400, 412). The prior art also disclosed that the noises caused by an internal combustion engine are of a complex character, being made up of a mixture of sound waves of both high and low frequency (R. 307–11, 394), and that a resonator, in a complex sound field, responds simultaneously to the frequencies which are within the range of its response (R. 429–430).

Limited claims were allowed by the Patent Office. The Examiner, however, rejected certain broad claims (R. 402–441), which had theretofore been allowed by previous Examiners (R. 181, 192), and the rejection, with the exception of three claims, was sustained by the Board of Appeals of the Patent

Office (R. 443–452). Petitioner thereupon filed suit (R. 1–10) in the United States District Court for the District of Columbia, seeking, under the provisions of section 4915 of the Revised Statutes, a declaration that it was entitled to the issuance of a patent on the rejected claims. The District Court allowed two of the claims [1] (R. 89, 90–92), found that the other claims disclosed no invention, and entered judgment accordingly [2] (R. 93–94). On appeal by petitioner to the Court of Appeals for the District of Columbia, the judgment was affirmed (R. 458). The Court of Appeals was of the view that the presence or absence of invention was doubtful and held that the findings of the Patent Office and the District Court should not be overturned unless clearly erroneous (R. 456).

ARGUMENT

The petitioner does not contend that the District Court's finding of no invention is without substantial support in the evidence. Petitioner's contention is that where, as the court below assumed, invention is doubtful, the applicant is entitled to the issuance of a patent, particularly where the device claimed has attained commercial success (Pet. 5–6). The decision of the court below, rejecting this contention and limit-

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[1] The claims allowed by the District Court in Nos. 45 and 92 (R. 93) differed from those rejected in that they disclosed a partially telescoped duct which communicated with the resonance chamber through the opening between the two elements of the duct. The petitioner apparently now contends (Pet. 4) that this feature was clearly disclosed in the prior patent to Powell (R. 304) and that the novelty upon which the allowance of these claims must, therefore, have been predicated is also disclosed in most of the claims disallowed by the District Court. At the hearing before the District Court, however, the petitioner's expert, Professor Chamberlain, testified that the Powell patent differed in material particulars (R. 84–85), and the Commissioner of Patents did not appeal from the District Court's allowance of these claims.

[2] The District Court made no finding of no invention in its findings of fact (R. 90–92); the finding of no invention was included, however, in the conclusions of law (R. 92). The court's omission to include the finding of no invention in its findings of fact was not mentioned in petitioner's statement of points on appeal to the court below (R. 95–98; 457), and since this point was not brought to the attention of the District Court (R. 457) the court below found it unnecessary to consider it (R. 457).

ing its review to the question whether there was substantial evidence to support the finding of no invention, is in accord with settled principles and presents no question which warrants review by this Court.

1. The question of invention is one of fact. *United States* v. *Esnault-Pelterie,* 299 U. S. 201, 205. The scope of appellate review under the provisions of section 4915 of the Revised Statutes, insofar as it relates to a question of fact, was accurately stated by the court below to be limited to the question of whether the finding that there was no invention was clearly wrong (R. 456). A proceeding under section 4915 of the Revised Statutes is an equity action, and follows the ordinary course of equity practice and procedure. *Butterworth* v. *Hoe,* 112 U. S. 50, 61. It is well established that the findings of fact of the trial court in an equity case will not be disturbed unless clearly erroneous or without support in the evidence. *Warren* v. *Keep,* 155 U. S. 265; *Furber* v. *Ferris,* 145 U. S. 132; *Tilghman* v. *Proctor,* 125 U. S. 136, 149; *Borden's Farm Products Co., Inc.* v. *Ten Eyck,* 297 U. S. 251, 261; *Great Atlantic & Pac. Tea Co.* v. *Grosjean,* 301 U. S. 412, 420. The doctrine is applicable in principle to proceedings under section 4915 of the Revised Statutes and has been so applied by the court below in previous cases. *Minnesota Mining & Mfg. Co.* v. *Coe,* 118 F. (2d) 593, certiorari denied October 13, 1941, Nos. 257, 258, 259, this Term; *Abbott* v. *Coe,* 109 F. (2d) 449, 451; *Wolf* v. *Coe,* 112 F. (2d) 857; *Eppensteiner* v. *Coe,* 114 F. (2d) 457; *Forward Process Co.* v. *Coe,* 116 F. (2d) 946, 947; cf. *Walker,* Patents (Dellers ed.), sec. 629. It is of peculiar force where, as here, the contested finding has been concurred in by both the Commissioner of Patents and the district court. *Abbott* v. *Coe,* at p. 452; cf. *United States* v. *Commercial Credit Co., Inc.,* 286 U. S. 63, 67.

The petitioner contends that where the presence or absence of invention is doubtful, the applicant is entitled to the issuance of a patent as a matter of law. This contention is without substance. The practice of the Patent Office, it is true, has been to

resolve doubt as to invention in favor of the applicant, in the view that the issuance of the patent confers no vested right, but merely enables the applicant to establish the validity of the patent in an infringement proceeding. *In re Thomsen*, 26 App. D. C. 419, 425. The practice is not required by statute, however,[3] and on principle, rejection of an application by the Patent Office should be sustained whenever "there is found to be a rational basis for the conclusions approved by the administrative body". *Mississippi Valley Barge Line Company* v. *United States*, 292 U. S. 282, 286–287; *Rochester Tel. Corp.* v. *United States*, 307 U. S. 125, 146.[4] The court below has consistently so held in previous decisions. *Minnesota Mining & Mfg. Co.* v. *Coe*, 118 F. (2d) 593, certiorari denied October 13, 1941, Nos. 257, 258, 259, this Term; *Forward Process Co.* v. *Coe*, 116 F. (2d) 946, 947; *Eppensteiner* v. *Coe*, 114 F. (2d) 457; *Wolf* v. *Coe*, 112 F. (2d) 857; *Abbott* v. *Coe*, 109 F. (2d) 449, 451; see also *Poulsen* v. *Coe*, 119 F. (2d) 188, 200, 203. In the view most favorable to petitioner, the duty of the district court in an equity proceeding under section 4915 is to make an independent determination of the factual issue of invention, and on settled principle, the determination of the district court must be sustained unless clearly erroneous or without substantial support in the evidence. See cases cited *supra*.

The cases referred to by petitioner (Pet. 17–19), involving a direct appeal from the Patent Office either to the Court of Customs and Patent Appeals or to the Court of Appeals of the District of Columbia prior to the transfer of jurisdiction of such appeals from the latter to the former court (Act of March 2, 1929, 45 Stat. 1475, 1476) do not aid petitioner. The Court of

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[3] The patent law authorizes the issuance of a patent to any person who has "invented or discovered any new or useful art," etc. (R. S. sec. 4886) and directs the Commissioner of Patents, on the filing of an application, to issue a patent if, upon examination, the applicant is "justly entitled to a patent under the law" (R. S. sec. 4893).

[4] In view of the practice of the Patent Office to resolve doubts in favor of the applicant, the action of the Commissioner in issuing a patent should be entitled to substantially less weight.

Customs and Patent Appeals has consistently held that where, as here, the claimed invention is of a technical character, the decision of the Patent Office tribunals should be affirmed unless clearly erroneous. *Angell* v. *Morin*, 69 F. (2d) 646 (Cust. & Pat. App.); *In re Demarest*, 38 F. (2d) 895 (Cust. & Pat. App.); *In re McDonald*, 47 F. (2d) 802 (Cust. & Pat. App.). Moreover, in such cases, the court is "part of the machinery of the Patent Office for administrative purposes" and renders "a mere administrative decision." *Postum Cereal Company* v. *California Fig Nut Company*, 272 U. S. 693, 698–699. Decisions in such proceedings, as the court below observed (R. 456), have no bearing on the scope of appellate review in judicial proceedings. *Minnesota Mining & Mfg. Co.* v. *Coe*, 118 F. (2d) 593, certiorari denied October 13, 1941, Nos. 257, 258, 259, this Term; *Abbott* v. *Coe*, 109 F. (2d) 449, 451.

The decisions of the court below in section 4915 proceedings, cited by petitioner (Pet. 20), do not support the petitioner's contention. In all of them the court held that the decision of the Patent Office and the trial court was clearly erroneous. *Thornton* v. *Coe*, 102 F. (2d) 247, 252; *Carbide & Carbon Chemicals Corp.* v. *Coe*, 102 F. (2d) 236, 242; *Battery Patents Corp.* v. *Coe*, 93 F. (2d) 220, 226–27. Cf. *Freyn Engineering Co.* v. *Coe*, 79 F. (2d) 134, 135. In cases of doubt the court below has consistently held that the findings of the Patent Office and the district court must be affirmed. See *Minnesota Mining & Mfg. Co.* v. *Coe*, 118 F. (2d) 593, 594, certiorari denied October 13, 1941, Nos. 257, 258, 259, this Term; *Forward Process Co.* v. *Coe*, 116 F. (2d) 946, 947; *Eppensteiner* v. *Coe*, 114 F. (2d) 457; *Wolf* v. *Coe*, 112 F. (2d) 857; *Abbott* v. *Coe*, 109 F. (2d) 449, 451; see also *Poulsen* v. *Coe*, 119 F. (2d) 188, 200, 203.

2. The petitioner contends that, where there is a substantial doubt of lack of invention, the courts, in a proceeding under section 4915, are required to resolve the doubt in favor of the applicant where the claimed invention has achieved commer-

cial success. The contention is without substance. The decisions of this Court establish that commercial success is a factor to be considered but is by no means conclusive. *Thropp's Sons Co.* v. *Seiberling,* 264 U. S. 320, 330; *McClain* v. *Ortmayer,* 141 U. S. 419. The cases cited by petitioner, as the language quoted in petitioner's brief discloses (Pet. 14–16), merely hold that commercial success may justify, but not compel, the conclusion that the patent is valid.

CONCLUSION

The decision below is in accord with settled principle and no conflict exists. It is respectfully submitted, therefore, that the petition for writ of certiorari should be denied.

CHARLES FAHY,
Acting Solicitor General.
FRANCIS M. SHEA,
Assistant Attorney General.
MELVIN H. SIEGEL,
ELLIS LYONS,
Attorneys.

NOVEMBER 1941.

U. S. GOVERNMENT PRINTING OFFICE: 1941

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1941.

No. 718.

GENERAL MOTORS CORPORATION, *Petitioner,*

v.

CONWAY P. COE, COMMISSIONER OF PATENTS, *Respondent.*

BRIEF OF AMICI CURIAE.

This brief is filed by William B. Kerkam and John J. Darby, as amici curiae on behalf of the American Patent Law Association, in support of the petition for writ of certiorari to the United States Court of Appeals for the District of Columbia filed in this cause on October 27, 1941.

This brief is directed to the following points:

1. That there is actually presented as a basis for decision in this cause, the question whether the United States Court of Appeals for the District of Columbia, in an action against the Commissioner of Patents under U. S. C. Title 35, Sec.

63, should resolve against the applicant for patent doubt as to the existence of invention;

2. That the United States Court of Appeals for the District of Columbia in an action under U. S. C. Title 35, Sec. 63 to obtain Letters Patent should not resolve doubts as to the presence or absence of invention against an applicant for patent, and that where such doubts are found to exist, the finding destroys any presumption as to the correctness of the District Court's decision;

3. That the decision of the United States Court of Appeals for the District of Columbia on this question is in conflict with decisions of other courts, and is in conflict with prior decisions of the Court of Appeals;

4. That an early authoritative resolution of the existing conflict of decision on this question is of general public importance.

I. The Question of the Effect of Doubt as to the Existence of Invention is Directly Involved in the Decision of the Court of Appeals.

In the opinion of the Court of Appeals of the District of Columbia in this cause (120 F. (2d) 736, Record 455-457) it clearly appears that the Court of Appeals recognized that the record before the Court indicated doubt as to the existence of invention in the subject-matter of the claims involved in the appeal.

The Court stated unequivocally:

> "We agree that the presence or absence of invention is doubtful in this case." (Record 456)

The Court then stated:

> "But 'whatever else may be said of older decisions that, in appeals from the Patent Office, doubt was to be resolved in favor of the applicant, they are obviously

not law in relation to appeals from the District Court' ",

citing *Minnesota Mining & Mfg. Co.* v. *Coe,* 118 F. (2d) 593, 594.

Since the "older decisions," which we discuss hereinafter at pages 4-5, would appear to have required a decision in favor of the inventor where doubt as to invention is found to exist, the ruling of the Court of Appeals on this question was apparently the determining factor in the decision.

II. The Finding by the Court of Appeals that Presence or Absence of Invention is Doubtful Automatically Eliminated the Presumption that the District Court was Correct Which Would Exist in the Absence of Such Finding.

The statement in the Court of Appeals decision (p. 2, *ante*) that the long established rule that doubts in appeals from the Patent Office are to be resolved in favor of an applicant is "obviously not the law in relation to appeals from the District Court", presumably refers to the rule that findings of a District Court shall not be set aside unless clearly erroneous*. Apparently, the Court regarded this latter rule as inconsistent with statements in its previous decisions that doubts should be resolved in favor of an applicant.

But there is no inconsistency between the two rules where, as in the case at bar, the Court of Appeals finds that doubt as to the presence or absence of invention does exist. The finding of the existence of a doubt automatically destroys the presumption as to the District Court's correctness, since it is equivalent to a holding that the District Court should have found a doubt, and it is the established

*Rule 52, Rules of Civil Procedure.

rule that where such a doubt exists, the District Court should issue the patent. See the decisions cited at pages 4-5.

Consequently, the presumption as to the District Court's correctness, which the Court of Appeals apparently had in mind in saying that its older decisions resolving doubts in favor of an applicant are not the law in relation to appeals from the District Court, has no application to this case. It is submitted that in any case where the Court of Appeals finds a doubt as to the presence or absence of invention, it should resolve that doubt in favor of the applicant in accordance with long-established precedent.

III. The Ruling of the Court of Appeals is in Conflict with Other Decisions of the Court of Appeals and with Decisions of Other Courts.

Heretofore it has been a uniform rule of decision, in the courts of the United States and in the tribunals of the patent system, that doubt as to the existence of invention should be resolved in favor of the inventor. We confine our consideration to cases involving a review of refusal of the Commissioner of Patents to issue a patent, since in such cases the resolution of doubt in favor of the inventor is not weighted by any presumption of validity of an issued patent.

1. *Prior Decisions of the Court of Appeals of the District of Columbia.*

Typical of the "older decisions" referred to by the Court of Appeals in its opinion in the present case is *Battery Patents Corporation* v. *Coe,* 93 F. (2d) 220 in which the Court said, at page 226:

> "We are aware that this court has said that in case of serious doubt in the mind of the court after a careful review of the evidence, the doubt should be resolved in favor of the one seeking a patent."

The Court of Appeals of the District of Columbia, when it exercised the jurisdiction under U. S. C. Title 35, Sec. 59a now held by the Court of Customs and Patent Appeals, followed the same rule. In the case of *In re Davidson*, 12 F. (2d) 814, the Court said:

> "Moreover, where the question of patentability is close, the doubt should be resolved in favor of the applicant". (Citing cases)

2. *Decisions of Other United States Courts.*

In appeals from the Patent Office to the Court of Customs and Patent Appeals under the provisions of U. S. C. Title 35, Sec. 59a, that Court has consistently followed the rule of resolving doubt of invention in favor of the inventor. In its opinion in *In re Coley*, 40 F. (2d) 982, the Court said:

> "Where there is such doubt, the scales should be inclined toward the applicant". (Citing cases)

In *In re Kirschbraun*, 44 F. (2d) 675, the same Court said:

> "The familiar rule that any doubt should be resolved in favor of the applicant is here applicable".

The United States District Court for the District of Maryland has confirmed the same rule of resolving doubt in favor of the inventor in cases heard by that Court under the provisions of U. S. C. Title 35, Sec. 63. *Berry* v. *Robertson*, 40 F. (2d) 915; *Kaplan* v. *Robertson*, 50 F. (2d) 617.

IV. The Public Interest Requires an Early Resolution of this Conflict.

It is highly undesirable that the rule of decision which will be followed in a case should depend upon the court in which the case may be heard. The evils resulting from

such a situation were pointed out by the Supreme Court in *Erie R. Co.* v. *Tompkins,* 304 U. S. 64.

It is furthermore desirable that a radical change in a long-established rule of decision should be reviewed by the Supreme Court, particularly when, as in the present case, the new rule of decision threatens substantially to nullify the right to a review of decisions of the Patent Office tribunals granted to inventors by U. S. C. Title 35, Sec. 63. The new rule of decision amounts, in effect, to an amendment of the Congressional enactment and inventors and the general public alike are entitled to have this alteration in the incidence of the statute carefully scrutinized by this Court.

Conclusion.

For the reasons outlined above, it is earnestly submitted that the present cause involves a reversal of a well-established rule of decision in conflict with a long line of prior decisions of the Court of Appeals of the District of Columbia and of other courts of the United States, clearly calling for review and determination of the conflict by this Court.

It is therefore requested that the petition for writ of certiorari filed herein be granted.

Respectfully submitted,

WILLIAM B. KERKAM,
JOHN J. DARBY,
Amici Curiae.

(33)

FILED
NOV 19 1941
CHARLES ELMORE CROPLEY
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1941.

No. 718.

GENERAL MOTORS CORPORATION,
Petitioner,

v.

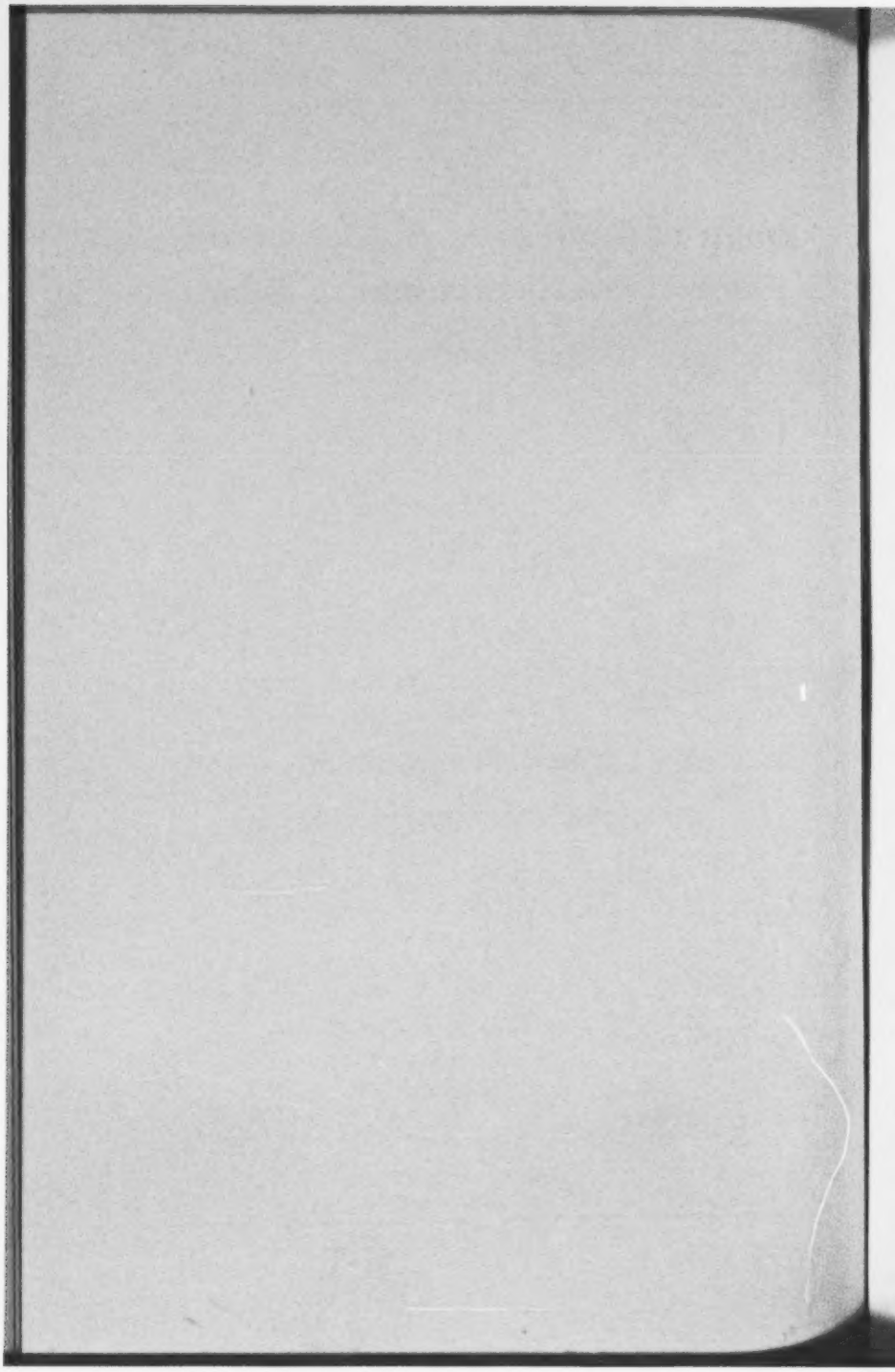
CONWAY P. COE, COMMISSIONER OF PATENTS,
Respondent.

REPLY BRIEF FOR PETITIONER.

GENERAL MOTORS CORPORATION,

By DRURY W. COOPER,
FRANK E. LIVERANCE, JR.,
Counsel for Petitioner.

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.



IN THE

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GENERAL MOTORS CORPORATION,
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REPLY BRIEF FOR PETITIONER.

The petition points out certain questions that are presented by the decision of the Court of Appeals in this case (Pet. 7-8). The respondent's brief does not controvert the proposition that these questions should be passed on by this Court.

The respondent's brief evades these questions. Most of it (the section numbered 1 on pp. 5-7) is devoted to a discussion of the scope of appellate review which the petitioner did not question. The very brief remainder of the respondent's brief (the section numbered 2 on pp. 7 and 8) purports to be a discussion of something which approximates a question the petition points out is presented by the

decision of the Court of Appeals but twists itself into a discussion of whether commercial success, of itself, conclusively entitles the applicant to the grant of a patent. The latter question was not presented to or passed on by the Court of Appeals and nothing with respect to it is found in the petition.

The *restatement* on page 2 of the respondent's brief of the questions presented are not only confusing but incorrect. The questions are clearly, concisely and accurately stated on pages 7 and 8 of the petition and we do not understand why the respondent should have considered it necessary to *restate* them as he did except as a basis for discussing something else.

The purpose of the petition in this case was not so much, as one might gather from the respondent's brief, to present our position with respect to a rule of law, as to urge that the Court settle which of two antagonistic rules, both by the Court of Appeals for the District of Columbia, is the proper rule of law to determine patentability in cases in which there is substantial, well-founded doubt of lack of invention.

SECTION 1 OF RESPONDENT'S BRIEF.

In this case the Court of Appeals did review the evidence and did find *as a fact,* and did not merely assume, that "the presence or absence of invention is doubtful in this case" (R. 456). Assuming that in effect, as the respondent contends (Resp. Br. 4, footnote 2), the District Court found no invention, this was a ruling that the finding of the District Court was "clearly erroneous or without support in the evidence."

Although there is in our mind no doubt that there is invention of high order in this case, we do not in the petition discuss that but proceed on the basis that the finding "the presence or absence of invention is doubtful in this

case"* presents the question whether the Court of Appeals applied the correct rule of law to such finding of fact.

As we showed on pages 24-26 of the petition, the questions presented by the petition are not answered by stating the rule of presumption of correctness of the decisions of lower tribunals. This rule and the rule as to resolution of doubt of lack of invention are separate and distinct; they are consistent rules and should not be confused as they have been by the Court of Appeals and the respondent.

The respondent says (Resp. Br. 6) resolution of doubt of invention in favor of the applicant is not required by statute, but we submit it is. R. S. Sec. 4915 (Resp. Br. 2) requires that the court determine "according to law" whether the applicant is entitled to a patent, and elementary law as we showed on pages 25 and 26 of the petition demands the rule.

The cases from the Court of Appeals of the District of Columbia on appeal from the Patent Office, from the Court of Customs and Patent Appeals, and from the District Court for the District of Maryland cited in the petition, contrary to respondent's assertion, do support the proposition to which we cited them, viz., that substantial, well-founded doubt of lack of invention is to be resolved in favor of the applicant. Quotations from decisions of these courts are found on pages 18 and 19 of the petition. No reason exists for a different rule in the Court of Appeals for the District of Columbia than in other courts.

The decisions of the Court of Appeals for the District of Columbia in actions under R. S. Sec. 4915, viz., *Thornton* v. *Coe, Carbide and Carbon Chemicals Corp.* v. *Coe, Battery Patents Corporation* v. *Coe* and *Freyn Engineering Co.* v. *Coe,* also support this rule. We quoted from *Freyn*

* Re the statement on page 4 of the respondent's brief that "The Petitioner does not contend that the District Court's finding of no invention is without substantial support in the evidence." The District Court made no "finding of no invention." In the petition, page 4, we pointed out that "The District Court made no finding of fact (R. 90-92) to support its conclusions that the claims it disallowed were not patentable." We do emphatically contend that a finding of no invention would have been not only "without substantial support in the evidence" but "clearly erroneous."

Engineering Co. v. *Coe* on page 20 of the petition. We quote below from *Thornton* v. *Coe* (102 F. 2d 252):

> "We think that Thornton's accomplishment of adjustability is such that *it cannot be said that want of invention is clear,* and we may therefore properly resort to utility and commercial success to remove any remaining doubt (citing Minerals Separation vs. Hyde; DeForest Radio Co. vs. Gen. Electric; Smith vs. Goodyear Dental Vulcanite). It appears that the problem of spreading the heads of the warper beams confronted the textile industry for at least *eight years* after the issuance of the patent to Peterson, before Thornton solved it with the adjustable disk; and it appears that Thornton's improvement was *a distinct success. This is highly persuasive of invention.*" (Italics supplied.)

Nothing could more clearly indicate the division in the Court of Appeals for the District of Columbia itself. *Thornton* v. *Coe* is the direct antithesis of the decision in this case.

It is immaterial whether or not the Court of Appeals in *Thornton* v. *Coe,* etc., held the decisions of the lower tribunals clearly erroneous. The important thing is that the Court of Appeals recognized that the rule of doubt as to invention applied by it in appeals from the Patent Office and applied by the District Court for the District of Maryland, the Court of Customs and Patent Appeals and the Patent Office was applicable to appeals in actions under R. S. Sec. 4915. When compared with these cases the decision in the present case is a departure from the previously universally applied rule and shows that the Court of Appeals itself is divided on the proper rule to apply in cases in which substantial, well founded doubt of lack of invention is found.

SECTION 2 OF RESPONDENT'S BRIEF.

The second of the "Questions Presented" (Res. 2) does not do justice to what the record shows. There was not mere commercial success, but (our footnote at p. 6 of the

petition) there was proof of all the factors accepted by courts as indicia of an especially meritorious invention, the first of its kind. Truly, there was commercial success of an extraordinary kind because of the exceptional practical merit of and need for the invention.

We make no contention that commercial success, of itself, will compel the grant of a patent, but we submit it is settled law that where there is doubt of lack of invention extraneous indicia of invention, of which commercial success is only an example, are resorted to to resolve the doubt in favor of patentability. The respondent does not controvert this; instead he sets up a straw man to knock down.

CONCLUSION.

The respondent's conclusion that "The decision below is in accord with settled principle and no conflict exists" is manifestly incorrect. The decision is contrary to previously settled and universally applied law and conflict manifestly exists. The question on which the decision of the Court of Appeals turned is of great importance and we, therefore, submit the petition should be granted and the decision reviewed.

General Motors Corporation,

By Drury W. Cooper,
Frank E. Liverance, Jr.,
Counsel for Petitioner.

Office - Supreme Court, U.
FILED
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CHARLES ELMORE CROP

No. 718

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941

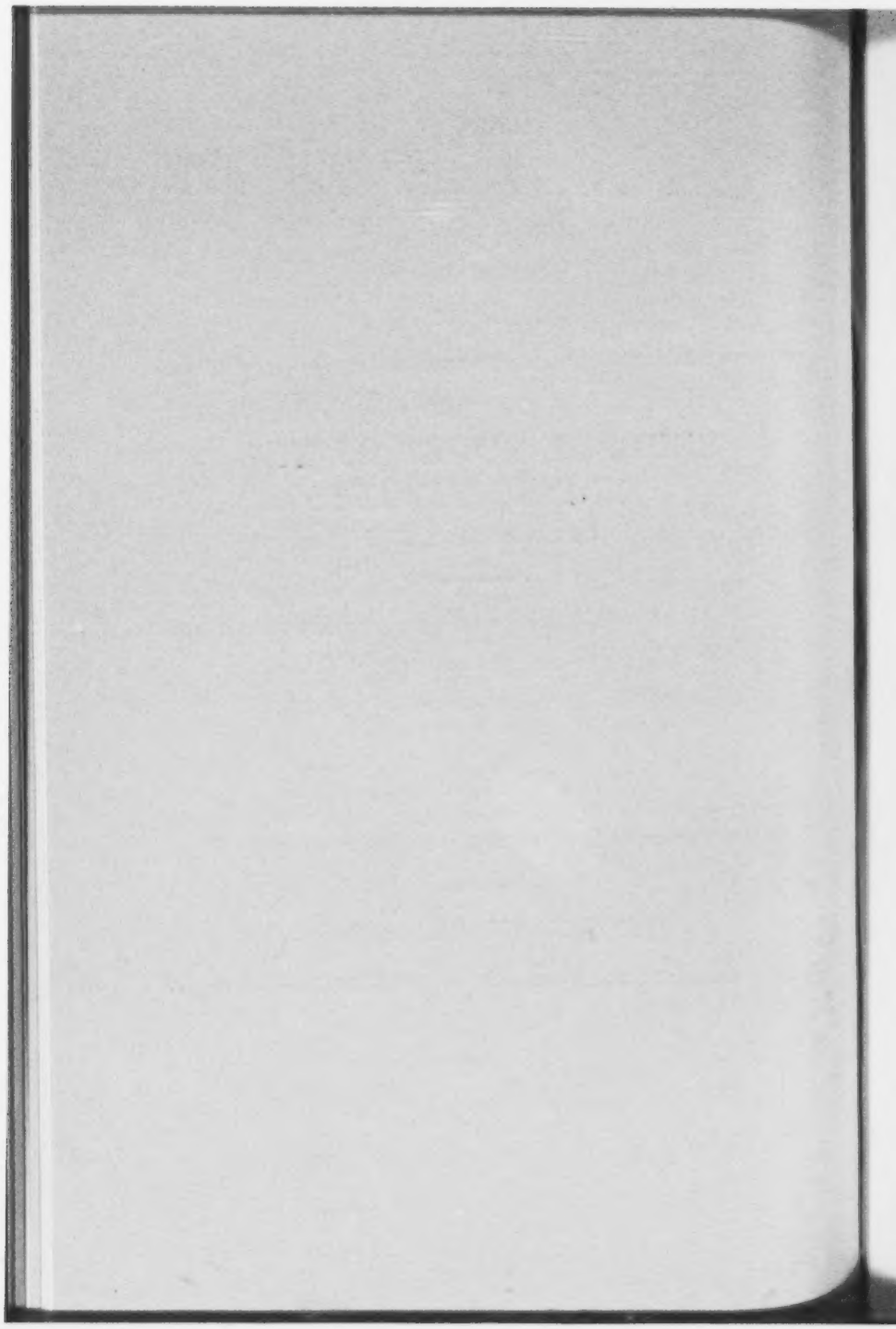
GENERAL MOTORS CORPORATION, PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS, RESPONDENT

ON PETETION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

PETITION FOR REHEARING



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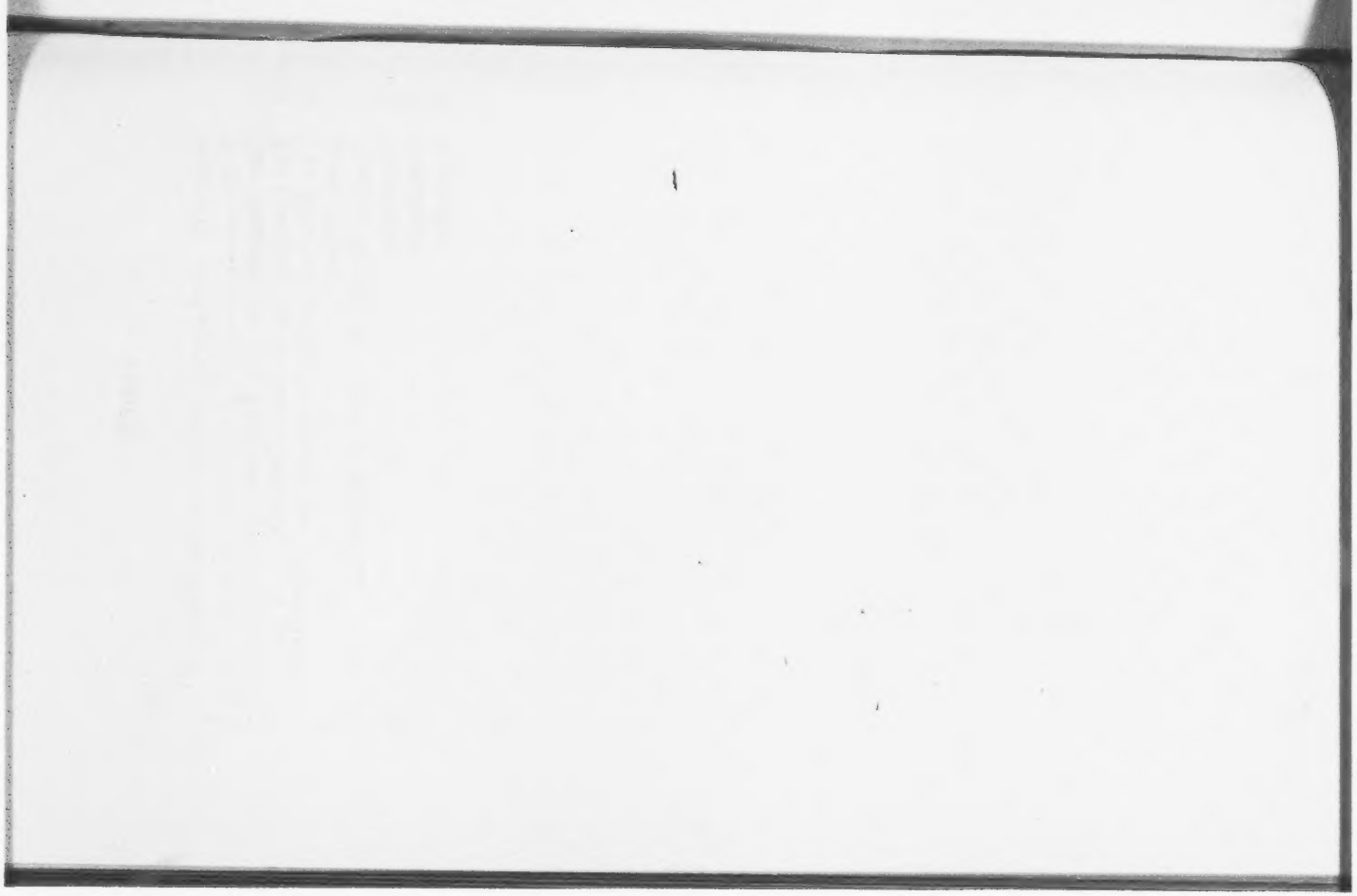

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PETITION FOR REHEARING

REQUEST FOR REHEARING

Petition for certiorari in the above entitled cause was denied November 24th, 1941. Petitioner respectfully presents its request for reconsideration.

SUMMARY OF REASONS RELIED ON FOR GRANT OF THE WRIT

A review was sought of the decision of the Court of Appeals for the District of Columbia upon a question of law with respect to applications for patents for inventions. In this cause the Court of Appeals made a ruling on the question directly opposite to the law theretofore followed from the beginning in such Court and in the other tribunals dealing with applications for patent. It was not a ruling

of the whole Court and there are differences of opinion today in the Court itself as to which of the two directly opposite rules is the proper rule. A ruling on the question by another United States Court of Appeals is impossible. This Court has not ruled on the precise question but the ruling of the Court of Appeals for the District of Columbia is in direct conflict with the rulings of this Court on a question which comprehends the question of law involved in this case. The ruling of the Court of Appeals makes it more difficult to get a patent than to sustain one. The question at issue is of great importance to inventors, all industry, large and small, and the country as a whole. Unless the ruling of the Court of Appeals in this case is revised by this Court it will, we predict, lead to the destruction of the patent system in this country. Public interest requires an early settlement of the conflict in rulings.

THE REASONS FOR THIS PETITION

We present this petition for rehearing because we are so thoroughly satisfied that this is the kind of a case of which the Court would take jurisdiction if it realized what was involved in it that we are apprehensive that it did not appreciate it when it denied the petition for writ of certiorari. Especially are we apprehensive that the brief of amici curiae on behalf of the American Patent Law Association and the petitioner's reply brief may have been filed too late to receive consideration by the Court and the Court may have accepted the statement of the case and the questions involved in it found in the respondent's brief.

The statement of the case and the questions involved in it found in the respondent's brief are unqualifiedly erroneous. This is not "just another patent case". This is not a case like Minnesota Mining and Mfg. Co. v. Coe in which this Court denied a writ of certiorari on October 13, 1941. The petition in this case raised no questions as to the scope of appellate review in cases of this kind and presented no contention that commercial success of itself called for the grant of a patent.

The decision in this case contains a direct reversal of previous settled law, which reversal was necessary to refuse the patent asked. The severe miscarriage of justice, as it affects the petitioner, which in itself ought to be corrected, is nevertheless of very minor importance compared to the damage which such reversal of the law will inflict upon all inventors, all progressive industrial business both large and small, and the public in general.

THE QUESTION THE PETITION PRESENTS

The question the petition presents and the only question it presents is whether a patent should be granted or denied in a case in which it is found as a fact that substantial well founded doubt of invention exists*, particularly if in addition to novelty and utility there appear overwhelming extraneous indicia of invention, always heretofore resorted to to resolve the doubt *in both obtaining and sustaining patents.*

In this case the Court of Appeals found that "the presence or absence of invention is doubtful" and its decision turned on its ruling on the question this petition presents. In Minnesota Mining and Mfg. Co. v. Coe there was no finding of doubt and the statement of the rule there advanced was pure *dictum.*

THE BRIEF OF AMICI CURIAE AND THE PETITIONER'S REPLY BRIEF

If the brief of amici curiae and the petitioner's reply brief were filed too late to receive consideration by the Court it was in no degree the fault of the amici curiae or the petitioner. The brief amici curiae was, we understand, filed as soon as the consent of the counsel for the respondent could be obtained. The petitioner's reply

*The nature of the right conferred by the grant of a patent, and the necessity of resolving substantial well founded doubt of lack of invention in favor of the inventor-applicant are developed in the appendix.

brief was filed as soon as possible after the respondent's brief was served.

The reply brief completely riddled the wholly erroneous contentions of the respondent. The brief of amici curiae fully supports our contentions with respect to the respondent's brief and the case presented by our petition for writ of certiorari. Moreover, the mere fact that a brief amici curiae was filed on behalf of the American Patent Law Association demonstrates that what is involved in this case is not merely a matter of interest to the petitioner only but is a matter of interest and importance to inventors, industry, industry, large and small, and the country as a whole. If the petitioner's reply brief and the brief of amici curiae were filed too late for consideration by the Court prior to its decision on the petition for writ of certiorari in this cause, it is respectfully requested that they be considered in conjunction with this petition for rehearing. If they were before the Court when it considered the petition for writ of certiorari it is respectfully requested that they be reconsidered in conjunction with this petition for rehearing.

CONFLICT WITHIN THE COURT OF APPEALS

That there are differences of opinion within the Court of Appeals for the District of Columbia with respect to the question presented by the petition for writ of certiorari in this cause, and that this case directly reversed previously settled law are evident from the following excerpts from the decisions of the Court of Appeals for the District of Columbia in this case and the case of *Thornton v. Coe*, 102 F. (2d) 247, 252

This Case

"Appellant urges that, although the appealed claims were finally rejected by the Examiner and the Board of Appeals in the Patent Office, claims as broad had previously been approved by two other Examiners. Appellant urges that the doubt thus created should be resolved in favor of the inventor, and against the Patent Office and District Court. *We agree that the presence or absence of invention is doubtful in this case.* But 'Whatever may be said of older decisions, that in appeals from the Patent Office *doubt was to be resolved in favor of the applicant*, they are obviously *not law in relation to appeals* from the District Court' ".

(Based on its own dictum)

Thornton v. Coe

"We think that Thornton's adjustability is such that *it cannot be said that want of invention is clear, and we may therefore properly resort to utility and commercial success to remove any remaining doubt* (citing Supreme Court decisions). It appears that the problem of spreading the heads of the warper beams confronted the textile industry for at least eight years after the issuance of the patent to Peterson, before Thornton solved it with the adjustable disk; and it appears that Thornton's improvement was a distinct success. *This is highly persuasive of invention.*"

(Based on Supreme Court authority)

(Italics supplied)

Thornton v. Coe, like this case, was an appeal from the District Court in an action under Sec. 4915, R. S. involving an ex parte application for patent. In this case all of the extraneous indicia of invention referred to in Thornton v. Coe were present. Obviously here are two antagonistic rules of law by the same Court, the final and only Court of Appeals in actions under Sec. 4915, R. S. where an ex parte appliction for patent is involved.

CONCLUSION

A long established and universally settled rule of law not only of the United States Court of Appeals for the District of Columbia but all other Courts should not be overturned by three only of the six Justices of such United States Court of Appeals for the District of Columbia. It is most undesirable that the rule of decision to be followed in a case should depend upon the Court in which the case may be heard and, more so, in any Court, that the rule should depend upon which members of the Court hear the case; and it is fully as undesirable that there should be side by side two antagonistic rules of law.

We submit that this case presents a question which should be reviewed by this Court and we, therefore, make this request for rehearing of the petition for writ of certiorari and particularly do we request rehearing of the petition in the light of the brief of amici curiae and the respondent's reply brief.

Very respectfully,

GENERAL MOTORS CORPORATION,
By DRURY W. COOPER,
FRANK E. LIVERANCE, JR.,
Counsel for Petitioner.

Grand Rapids, Michigan.
December 11th, 1941.

CERTIFICATE

It is hereby certified that the petition for rehearing is believed to be well-founded in law and fact and that it is made in good faith and not for any purpose of delay.

FRANK E. LIVERANCE, JR.

APPENDIX

At first blush it may appear that the rule of resolving doubt of invention lack in favor of the applicant is anomalous and not justified. But a patent is a peculiar piece of property. *It is not a monopoly* carved out of the existing public domain and conferred on an individual.* It is a right granted in consideration of adding to the public domain. Practically, grant of a patent is merely giving a right to bring an action to establish the exclusive control for a short time of the addition to the public domain which the inventor has made. If the Court in which the action is brought finds that the supposed consideration for which the patent was granted did not exist or is insufficient it will dismiss the action. Therefore, nothing is taken from the public domain and no monopoly is created by the grant of a patent for an invention.

By filing a patent application an inventor applies for a right to bring action to establish his lawful title to what he conceives has been an addition to the public domain created by himself. In France, and other countries such application (for patent) for a right to sue to establish such title has been permitted as of course. By applying and disclosing the purported invention the applicant strips himself for all time of his natural right to keep to himself the new thing which he has created. Having taken such irrevocable step, he should not be denied the right to a day in Court to prove his title to the new thing which he has created unless it *clearly appears* that what he thought was new and inventive was not. And this is all the rule as to resolution of doubt of invention heretofore followed provides.

If in fact what the inventor thought he created clearly was *not new and inventive* then he should be and is denied a right to bring actions against others. There is

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*This is elementary. It is the first thing the elementary student of patent law reads in the first chapter of Walker on Patents (Sixth and other editions).

never any trouble when there is direct or substantial anticipation, for then there is no doubt that there is no novelty or invention and no excuse for giving the right to bring the action, — a patent. But if there is not such certainty, in other words, if there is substantial doubt, the right to bring action should be and always before has been given.

The resolving of substantial well founded doubt of invention in favor of the applicant is an essential to the existence of the patent system. Otherwise a patent cannot be obtained unless the inventor can prove beyond a doubt that what he created was of inventive character. This would be possible in few, if any, cases because unless the prosecution of the patent application was prolonged there would not be the opportunity for adequate commercial exploitation of the invention before the prosecution was terminated.*

Resolving substantial well founded doubt of invention in favor of the applicant to obtain the grant of a patent, which is only a right to bring suit and is not a conclusive holding of title, is a practical, workable rule and one which has worked successfully for better than 100 years. Certainly, when the Supreme Court itself has from time immemorial held that where the facts of the case show invention to be in doubt, resort may be had to the legal evidence and indicia of invention to resolve the doubt, there

*Even in such case, as with the Wilson invention in which the applicant's prosecution was prolonged, there was novelty and great and exclusive commercial exploitation and every evidential factor which resolves doubt in favor of invention was proven, the patent was refused because the Court did not hold invention proven beyond duobt. Evidently such ruling is going to make the Patent Office bureau an unrestrained czar in connection with patent applications. It can refuse patents that it wants to upon merely expressing someone's doubt of invention. There is establishment of bureaucratic domination of inventors. The servant becomes the master.

should at least on the same record which would sustain an issued patent be a grant of a patent so that the applicant shall not be irremediably foreclosed from a right to bring action to establish title to the property which he has created.

The rule of resolution of substantial well founded doubt as to invention is founded on a sound legal principle. A patent application with the prescribed oath makes a prima facie case of invention. The burden of showing lack of invention is thus put upon the Commissioner of Patents. And if the case made by him does no more than raise a doubt of invention it is obviously insufficient to overcome the presumption and the patent should be granted.

The rule of resolution of substantial doubt as to invention and the rule that an appellate tribunal will not disturb the decision of a lower tribunal because of mere doubt as to its correctness are separate, distinct and consistent rules. The former rule says that if absence of invention does not clearly appear the patent is to be granted. A finding by an appellate tribunal that "the presence or absence of invention is doubtful", therefore, establishes patentability and patentability having been established the decision denying patentability becomes manifestly erroneous and should be reserved.

The dispute in this case is not whether an invention is disclosed. A number of claims have been allowed an invention thus conceded. The dispute is whether the broader claims sought are within the *scope* of the invention. Claims are included in patents in compliance with the statutory requirement that what is considered the invention be particularly pointed out and distinctly claimed. It is settled that a patent comprehends nothing beyond the scope of its claims regardless of the actual scope of the invention. So refusal of claims commensurate in scope with the real invention is a refusal of a patent on the whole of the invention and irreparably damages the inventor. On the other hand the allowance of claims broader than the real invention is correctable. In the

first action in which they are asserted they will be held invalid or construed down to their proper scope.

In this case claims have been allowed and invention thus conceded. The question then is not as to the presence or absence of invention but as to the *scope* of the invention. Obviously it is more difficult to determine the scope of an invention than to determine whether there is an invention. The drafting of claims no more limited and no broader than the real invention, involving as it does consideration of all of the prior art and the employment of just the right words and expresions, is a very difficult job, particularly in a case like this where intangible rather than concrete mechanical elements are being dealt with. Therefore, we submit that especially in a case like this in which claims have been allowed and invention thus conceded and twice previously claims of identical scope with those in this case were granted, the rule of resolution of doubt of the lack of invention in favor of the inventor should be applied.

If the firmly established, practical, logical and essential rule of resolving substantial, well-founded doubt of lack of invention in favor of the applicant had been followed at any stage in the proceedings in this application the patent would have been allowed by any tribunal which handled it. The lower tribunals could not but have had substantial well-founded doubt of lack of invention and the Court of Appeals conceded and expressly found it based upon circumstances present in the case before the appealed claims were refused the first time by the third examiner, and which every tribunal of review had presented to it. To deny your petitioner a patent it was necessary in each instance that the established rule of resolution of such doubt be ignored and flouted (R. 446) until the Court of Appeals, recognizing the settled rule reversed it and pronounced a diametrically opposite rule.

If all that is involved in this case was whether or not a patent should be granted on this application, this petition for certiorari would not, in all likelihood, have been filed. Not that the petitioner's interest in the application would

have been any less, but it would have probably been considered a futile gesture because of interest only to the petitioner. But much more became involved in this case when the Court of Appeals sitting in this case announced its rule regarding doubt of lack of invention, overturning and reversing that theretofore universally followed. This pronouncement of the opposite rule and the decision of this case on that opposite rule changed this case from one which might have affected the interest of the petitioner alone to one which changed the patent law and threatens to destroy the whole patent system of this country. For this reason it was earnestly believed that the importance of the case and the nature of the questions involved were such that this Court would entertain a petition for writ of certiorari. The general interest and importance to inventors and owners of applications for patent on inventions is demonstrated by the intervention and vigorous attack by the American Patent Law Association in this case upon such reversal of established law.

A very long step in the direction of seriously crippling, if not substantially destroying, the patent system has been taken by the Court of Appeals for the District of Columbia in this case.

To develop and make available to the public new products is time consuming and expensive. Giving to inventors the opportunity to reimburse themselves for the time and money spent and receive reward for the inventions made is the incentive for producing inventions, thus insuring the technological and social progress of the country. It is the wise purpose of the Constitutional provision with respect to patents and the patent laws that the inventors shall be protected and thus encouraged to promote the sciences and useful arts. The Constitutional provision and statute based thereon should not be allowed to be nullified without mature serious thought and consideration and certainly not without the direct passing thereupon by the highest Court.